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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,102	02/27/2002	Michael Schmid	P2001,0140	6793

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EXAMINER

LEON, EDWIN A

ART UNIT	PAPER NUMBER
2833	

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/084,102	SCHMID, MICHAEL	
	Examiner Edwin A. León	Art Unit 2833	
<p>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</p> <p><b>Period for Reply</b></p> <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>			
<b>Status</b>	<p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>29 October 2002</u>.</p> <p>2a)<input checked="" type="checkbox"/> This action is FINAL.                  2b)<input type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>		
<b>Disposition of Claims</b>	<p>4)<input checked="" type="checkbox"/> Claim(s) <u>1 and 3-13</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) _____ is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>1 and 3-13</u> is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8)<input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p>		
<b>Application Papers</b>	<p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on _____ is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p>11)<input type="checkbox"/> The proposed drawing correction filed on _____ is: a)<input type="checkbox"/> approved b)<input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.</p> <p>12)<input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
<b>Priority under 35 U.S.C. §§ 119 and 120</b>	<p>13)<input checked="" type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input checked="" type="checkbox"/> All b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <ol style="list-style-type: none"> <li>1.<input checked="" type="checkbox"/> Certified copies of the priority documents have been received.</li> <li>2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</li> <li>3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> </ol> <p>* See the attached detailed Office action for a list of the certified copies not received.</p> <p>14)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). a)<input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>15)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>		
<b>Attachment(s)</b>	<p>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u>.</p> <p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____.</p>		

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed October 29, 2002 in which Claims 1, 6-8 and 13 have been amended and Claim 2 has been cancelled, has been place of record in the file as Paper No. 5.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in–
  - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
  - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Gierut (U.S. Patent No. 6,122,161). With regard to Claim 1, Gierut discloses a printed circuit board configuration, comprising: a first printed circuit board (Module 1) having first defined dimensions corresponding to a first standard and a first portion (14a) of a plug connector (14), the first printed circuit board (Module 1) extending in a given plane

and being a main board of a data processing device (See Column 2, Lines 54-61); a second printed circuit board (Module 2) having a second portion (14b) of the plug connector (14), the second printed circuit board (Module 2) connectable to the first printed circuit board (Module 1) through the plug connector (14) to form a connected configuration; the first (Module 1) and second (Module 2) printed circuit boards both extending in the given plane when connected in the connected configuration; and the second printed circuit board (Module 2) having dimensions such that the connected configuration has second defined dimensions corresponding to a second standard. See Fig. 1.

With regard to Claim 8, Gierut discloses a printed circuit board assembly, comprising: a first printed circuit board (Module 1) having dimensions corresponding to a first dimension standard, the first printed circuit board (Module 1) substantially extending in a given plane being a main board of a data processing device (See Column 2, Lines 54-61); a second printed circuit board (Module 2) removable connected to the first printed circuit board (Module 1); the first (Module 1) and second (Module 2) printed circuit boards forming a connected configuration when the second printed circuit board (Module 2) is connected to the first printed circuit board (Module 1); and both extending in the given plane when connected in the connected configuration; and the second printed circuit board (Module 2) being dimensioned to have the connected configuration correspond to a second dimension standard. See Fig. 1.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-7, and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gierut (U.S. Patent No. 6,122,161) inview of Leman (U.S. Patent No. 6,046,912). With regard to Claims 3-7 and 9-13, Gierut discloses the claimed invention except for the first standard being the µATX dimension standard, the second standard being the ATX dimension standard, and the second printed circuit board having slots for receiving plug-in cards.

Leman discloses an assembly having a circuit board (300) having a well known ATX dimension standard and slots (306) for receiving plug-in cards. See Fig. 5 and Column 2, Lines 32-42.

Thus, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the assembly of Gierut by using boards with a well known ATX or any other well known dimension standard and slots for receiving plug-in cards as taught in Leman to make the assembly suitable for computer systems.

***Response to Arguments***

6. Applicant's arguments filed October 29, 2002 have been fully considered but they are not persuasive. In response to Applicant's arguments regarding Claims 1 and 8 that the Gierut reference doesn't show the first or the second printed circuit boards being an independent units, Applicant misinterprets the principle that claims are interpreted in the light of the specification. Although these elements are found as examples or embodiments in the specification, they were not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. In the instant case, Applicant's claims only state the first printed circuit board being a main board. As stated in Column 2, Lines 54-61 of the Gierut reference, Module 1, which contains the memory (30b), can be consider the main board since there is no further structural details recited.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin A. León whose telephone number is (703) 308-6253. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Edwin A. Leon  
AU 2833

EAL  
December 31, 2002

*P. Bradley*  
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